

RESPONSE UNDER 37 C.F.R. § 1.111  
U.S. Appln. No. 10/606,845  
Attorney Docket No. Q76336

**REMARKS**

Claims 1-21 are pending. Claims 1, 5, 7, 8, 11 and 13-16 have been withdrawn from consideration. Claims 2-4, 6, 9-10, 12, 17-20 and 21 are under consideration.

In Paragraph VI of the Action, the Examiner states that the record shows that Applicants, Fuji Photo Film Co. and their counsel, “failed to bring to the Office the related applications, especially with at least 10/361,505, 10/613,044 and 10/654,942.”

Applicants respectfully submit that the ‘505, ‘044 and ‘942 applications were not considered material to the present application, as will be apparent from the following.

In Paragraph VII of the Action, the “elected invention” of claims 2-4, 6, 9-10, 12, 17-20 and 21 is provisionally rejected for obviousness-type double patenting as allegedly being unpatentable over (1) claims 2-8 and 16 of co-pending application number 10/361,505; (2) claims 16-20 of co-pending application 10/613,044; and (3) claims 3-4, 6, 8, 11-12, 14, 16 and 18 of, Applicants assume, co-pending application 10/654,942. (The citation of the co-pending application number is missing from the Action).

The Examiner states that while the conflicting claims are not identical, they are not patentably distinct from each other because “they contain the same or about the same requisite chemical ingredients which are not found to be patentably different or distinct.”

The Examiner notes that this is a provisional rejection because the conflicting claims have not in fact been patented.

Insofar as the rejection is based on the co-pending ‘505 application, Applicants respectfully traverse.

RESPONSE UNDER 37 C.F.R. § 1.111  
U.S. Appln. No. 10/606,845  
Attorney Docket No. Q76336

The species elected by Applicants, that is, compound A-1 at page 22 of the present specification, is within the scope of formula (3) in claim 3 of the '505 application. Further, the genus of formula (III) of the co-pending application and the genus of the formula (1) of the present claims overlap.

However, there is nothing in claims 2-8 and 16 of the '505 application which discloses or suggests that the positive resist composition should include the compound (A) of present claim 2 in an amount of from 3.6 to 15 weight % based on the solids content of the composition. This requirement of the present claims is completely missing in the '505 application claims.

Applicants traverse for at least the above reason.

As to the co-pending '044 application, Applicants respectfully traverse the rejection.

In regard to claim 16 of the co-pending '044 application, elected compound A-1 at page 22 of present specification is within the scope of formula (VIII) in claim 16. See claim 13, from which claim 16 depends. Also, the genus of formula (VIII) and the genus of formula (1) of present claim 2 overlap.

However, claim 16 (which depends from claim 13) recites (D1) an alkali-soluble resin. It does not disclose or suggest a resin capable of increasing in solubility in an alkali developer under the action of an acid, as recited in present claim 2.

Further, there is nothing in claim 16 which discloses or suggests that the composition comprises the compound (A) in an amount from 3.6 to 15 weight % based upon the solids content of the composition, as recited in present claim 2.

RESPONSE UNDER 37 C.F.R. § 1.111  
U.S. Appln. No. 10/606,845  
Attorney Docket No. Q76336

As to claims 17-20 of the co-pending '044 application, none of these claims disclose or suggest that the composition should comprise the compound (A) in an amount of from 3.6 to 15 weight % based on the solids content of the composition, as recited in present claim 2.

Applicants traverse the rejection at least on these bases.

As to the co-pending '942 application, Applicants respectfully traverse the rejection.

Elected species A-1 at page 22 of the present specification is within the scope of formula (1) in claim 3 of the co-pending application. Also, formula (1) of the co-pending application and formula (1) of the present application overlap. However, as in the case of the other co-pending applications, there is nothing in the co-pending '942 application claims which discloses or suggests that the composition should include the compound (A) in an amount of from 3.6 to 15 weight % based on the solids content of the composition, as recited in the present claims.

Applicants traverse on at least this basis.

With respect to all of the double patenting rejections, none of the relied-upon claims of the co-pending applications disclose or suggest the particular combination of repeating units recited in present claim 3 for the resin (D), nor do any of the claims of the co-pending applications disclose or suggest the molar ratio of those repeating units as recited in present claim 4. These are further bases of distinction over the claims of the co-pending applications.

For all of these reasons, Applicants respectfully traverse the obviousness-type double patenting rejections set forth in Paragraph VII of the Action. Reconsideration and withdrawal of the rejections is respectfully requested.

RESPONSE UNDER 37 C.F.R. § 1.111  
U.S. Appln. No. 10/606,845  
Attorney Docket No. Q76336

In Paragraph VIII of the Action, the Examiner states that the elected invention of claims 2-4, 6, 9-10, 12, 17-20 and 21 with respect to the elected and applied species is rejected under 35 U.S.C. § 103(a) as being unpatentable over Sinta et al (US 5,731,364) and Sato et al (6,238,842).

Applicants submit that this rejection should be withdrawn because Sinta et al and Sato et al do not disclose or render obvious the positive resist composition of the present invention.

The Examiner states that Sinta et al discloses and teaches a positive resist composition comprising a sulfonium and its counter ion “being read within the general formula I as claimed and resin being read on the type as claimed,” pointing to compound (A) at column 6, lines 1-22 of Sinta et al and Example 2 of Sinta et al.

Applicants respectfully submit that the compound (A) at column 6, lines 1-22 of Sinta et al is not within the scope of formula (1) of the present claims. In this regard, the central sulfur atom in compound (A) of Sinta et al is not found in the compounds of formula (1) of present claim 2.

As to Example 2 of the Sinta et al, which begins at column 18, line 60 of Sinta et al, the Examiner apparently relies upon this example because it employed, among other compounds, the compound (A) relied upon by the Examiner. See Sinta et al at column 19, lines 15-17. As discussed above, compound (A) is not within the scope of the present invention. Thus, Example 2 of Sinta et al does not disclose or render obvious the positive resist of the present invention.

With respect to present claims 3 and 4, there is no disclosure or suggestion in Sinta et al of the use in combination of repeating units represented by formula (IV) and formula (V) as

RESPONSE UNDER 37 C.F.R. § 1.111  
U.S. Appln. No. 10/606,845  
Attorney Docket No. Q76336

recited in present claim 3, let alone in the molar ratio recited in present claim 4. See generally the disclosure cited by the Examiner at column 8, line 31 to column 9, line 51 of Sinta et al.

As to Sato et al '842, this document does not make up for the deficiencies of Sinta et al, although it does, as stated by the Examiner, disclose the use of a nitrogen-containing basic compound.

In view of the above, Applicants respectfully request that the § 103 rejection of claims 2-4, 6, 9-10, 12, 17-20 and 21 over Sinta et al and Sato et al be reconsidered and withdrawn.

In Paragraph IX of the Action, the Examiner states that the elected invention of claims 2-4, 6, 9-10, 12, 17-20 and 21 with respect to the elected and applied species is rejected under 35 U.S.C. § 103(a) as being unpatentable over Inoue et al (US 6,406,830).

Applicants submit that this rejection should be withdrawn because Inoue et al does not disclose or render obvious the positive resist composition of the present invention.

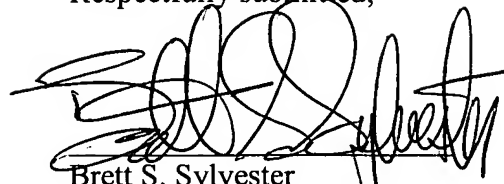
Present claim 2 recites that at least two of the  $X^+$ s connected with B are in a conjugated system. The meaning of this phrase is explained at page 19 of the present specification. The aliphatic sulfonium salts represented by formula (I) of Inoue et al do not satisfy this requirement. That is, the group connecting the sulfur ions in formula (I) of Inoue et al does not have a conjugated structure. Nor does Inoue et al suggest such a structure.

In view of the above, Applicants respectfully request that the § 103 rejection of claims 2-4, 6, 9-10, 12, 17-20 and 21 over Inoue et al be reconsidered and withdrawn.

RESPONSE UNDER 37 C.F.R. § 1.111  
U.S. Appl. No. 10/606,845  
Attorney Docket No. Q76336

Allowance is respectfully requested.

Respectfully submitted,



Brett S. Sylvester  
Registration No. 32,765

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: March 10, 2005